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PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK NJ 08933-7003

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OFFICE OF PETITIONS

In re Application
Jonathan Fanger et al.
Application No. 10/664,575
Filed: September 17, 2003
Attorney Docket No. **DEP5150USCIP1**

DECISION ON APPLICATION
FOR PATENT TERM ADJUSTMENT

This is in response to the APPLICATIONS FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(b) WITHIN THREE MONTHS OF RECEIPT OF THE NOTICE OF ALLOWANCE filed August 17, 2010. Applicant requests that the determination of patent term adjustment be corrected from 464 days to 1133 days. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent and is being considered in light of the Court of Appeals for the Federal Circuit's decision in *Wyeth v. Kappos*, 2009-1120 (Fed. Cir. 1-7-2010).

To the extent that this application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for

continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

With respect to the over 3 year calculation, rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.

To the extent that applicant otherwise requests correction of the patent term adjustment at the time of the mailing of the Notice of Allowance, the application for patent term adjustment is **GRANTED** to the extent indicated herein.

On May 17, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 464 days. The instant application for patent term adjustment was timely filed¹ on or before payment of the issue fee.

Applicants do not dispute 442 days of Examination delay and 25 days of Applicant delay. However, with respect to the patent term adjustment at the time of the mailing of the notice of allowance, Applicants argue that the patent term adjustment of 464 days included with the Notice of Allowance, based on PAIR, appears to be attributable to "A delay". No "B delay" or "C delay" was identified. Applicant considers the PAIR "A delay" calculation of 464 days to be 157 days more than Applicant is entitled to and that Applicant is entitled to 803 days of "B delay" adjustment and 23 days of "C delay" adjustment.

Applicants argue that in response to a Final Office Action mailed on November 17, 2006, they filed an amendment on January 16, 2007 under 37 C.F.R. § 1.116 and further, in response to an Advisory Action mailed March 20, 2007, on March 20, 2007, filed a Notice of Appeal, along with a Request for Extension of Time for one month. Applicants argue that the period of delay between when the statutory period of three months expired and when the Notice of Appeal was filed was 31 days in accordance with 37 CFR 1.704.

¹ PALM records indicate that the issue fee was paid on August 17, 2010.

In this instance, as the amendment filed January 16, 2007 was not in compliance with § 1.113(c), the period for reply to the final rejection continued to run. The proper reply, a Notice of Appeal, was not received in the Office until March 20, 2007. The filing of the Notice of Appeal on March 20, 2007 is considered a failure to engage under 1.704(c)(8). Pursuant to § 1.704(b), the patent term adjustment should have been reduced by 31 days for applicant delay from February 17, 2007 to March 20, 2007, the date of filing of a reply in compliance with § 1.113(c). In view thereof, since the Office Action mailed July 2, 2007 was mailed within 4 months of the filing date of the notice of appeal on March 20, 2007, the 47 day delay accorded the Office was incorrect.

Applicants argue further that after the filing of the Request for Continued Examination (RCE) and Information Disclosure Statement (IDS) on February 16, 2010, a Supplemental IDS was filed on May 6, 2010 and thus Applicants should have received a reduction in the amount of 79 days.

Applicant's arguments have been considered. Pursuant to 37 CFR § 1.704(c)(8), the submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, is a failure to engage in reasonable efforts to conclude prosecution.

In this instance, the filing of the second IDS on May 6, 2010 is considered a failure to engage under 1.704(c)(8). The record does not support a conclusion that the IDS was expressly requested by the examiner and neither did the IDS include a 1.704(d) statement.

Finally, in view of the successful appeal decision by the Board of Patent Appeals and Interferences, Applicants argue an entitlement to a patent term adjustment of 23 days for the period from the filing of the notice of appeal on March 20, 2007 to the date of the pre-appeal panel decision on April 11, 2007. In view of the Pre-Appeals Conference Decision of April 11, 2007 which withdrew the Final Office Action mailed November 17, 2006 and issued a non-Final Office Action, the amendment filed January 16, 2007 was treated as if filed after non-Final. In such case the subsequent Notice of Appeal is not treated as a supplemental reply given that it was required by the improper Final OA thus, the Notice of Appeal filed on March 20, 2007 does not put PTA time "on hold" and the calculation for the period from March 20, 2007 to the date of the Pre-Appeals Conference Decision of April 11, 2007 in the amount of 23 days, should have been attributed to the Office for Examination delay.

In view thereof, it is concluded that the determination of patent term adjustment at the time of the mailing of the Notice of Allowance is 330 days (442+23 Examination delay days minus 25+31+79 Applicant delay days)

The Office acknowledges the authorization to charge the \$200.00 fee set forth in 37 CFR 1.18(e) to deposit account no. 10-0750.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3212.



Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions